

REMARKS

The paper is in response to the Office Action mailed December 23, 2008 ("the Office Action"). The foregoing amendment cancels claims 2-3, 5-6 and 17-21, and amends claims 1 and 4. Claims 1, 4, 7-9 and 11-16 are now pending in view of the amendments. Applicants respectfully request reconsideration of the application in view of the above amendments to the claims and the following remarks. For Examiner's convenience and reference, Applicants present remarks in the order that the Office Action raises the corresponding issues.

I. General Considerations

a. present understanding of the references

In connection with the prosecution of this case and any related cases, Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Because such discussion could reflect an incomplete or incorrect understanding of one or more of the references, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable. Applicants thus hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to any reference.

b. remarks

With particular reference to the claim amendments and cancellations, Applicant notes that while claims 1 and 4 have been amended herein, and claims 2-3, 5-6 and 17-21 have been canceled herein, such amendments and cancellations have been made in the interest of expediting the allowance of this case. Notwithstanding, Applicants, may, on further consideration, determine that claims of broader scope than those now presented are supported. Accordingly, Applicants hereby reserve the right to file one or more continuing applications with claims broader in scope than the claims now presented.

Consistent with the points set forth above, Applicants submit that neither the claim amendments set forth herein, nor any other claim amendments, claim cancellations or statements advanced by the Applicants in this or any related case, constitute or should be construed as, an implicit or explicit surrender or disclaimer of claim scope with respect to the cited, or any other, references.

Applicants respectfully note that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the patentable distinctions between any cited references and the claims. Rather, and in consideration of the fact that various factors make it impractical to enumerate all the patentable distinctions between the claims and the cited art, as well as the fact that the Applicants have broad discretion in terms of the identification and consideration of the base(s) upon which the claims distinguish over the cited references, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration by the Applicants, in this case or any other, of: additional or alternative distinctions between the claims and the cited references; and/or, the merits of additional or alternative arguments.

Applicants note as well that the remarks, or a lack of remarks, advanced by the Applicants in this case are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicants: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicants reserve the right to challenge the purported teachings and purported prior art status of the cited references at any appropriate time.

II. Rejection under 35 U.S.C §103(a)

The Office Action rejects claims 1, 4, 7-9, 11, 14, 15, 17, 18, and 21 under 35 U.S.C §103(a) over *Davidson* (U.S. Patent Publication No. 2003/0063354) in view of *Robinson et al.* (U.S. Patent Publication No. 2002/0135845) and rejects claims 2, 3, and 5 under 35 U.S.C §103(a) over *Davidson* in view of *Robinson et al.* as applied to claim 1 above, and in further view of *Bayart* (U.S. Patent No. 6,069,731). The Office action also rejects claim 6 under 35 U.S.C §103(a) over *Davidson* in view of *Robinson et al.* as applied to claim 1 above, and in further view of *Schild et al.* ("Amplifier Array for 12 Parallel 10 Gb/s Optical-Fiber Links Fabricated in a SiGe Production Technology") and rejects claim 16 under 35 U.S.C §103(a) over *Davidson* in view of *Robinson et al.* as applied to claim 1 above, and in further view of *Schild et al.* ("Amplifier Array for 12 Parallel 10 Gb/s Optical-Fiber Links Fabricated in a SiGe Production Technology"). The Office action also rejects claims 12, 13, and 19 under 35 U.S.C

§103(a) over *Davidson* in view of *Robinson et al.* as applied to claims 1, 17, and 18 above, and in further view of *Geller* (U.S. Patent No. 5,202,553) and rejects claim 20 under 35 U.S.C. §103(a) over *Davidson* in view of *Robinson et al.* as applied to claim 17 above, and in further view of *Schild et al.*

As to claims 2-4, 5-6 and 17-21, Applicants disagree with the contentions of the Examiner but submits that in view of the cancellation of those claims, the rejection of those claims is moot and should be withdrawn.

Under 35 U.S.C §103(a), "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." According to MPEP §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Finally, MPEP 2141.III notes that:

"The key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious*. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396." (emphasis added)

By this paper, Applicants have amended claim 1 (from which all other pending claims now depend) to recite in part "...wherein the plurality of amplifiers each include a supply voltage connection and at least a separate input amplifier stage and a separate output amplifier stage...a plurality of electrical switches, each of which is arranged in series between the optical receiving device and a respective amplifier; circuit means for individually activating and deactivating the individual amplifiers by regulating a supply voltage to each of the amplifiers or by controlling the electrical switches; wherein the plurality of electrical switches enable the electrical signal from the optical receiving device to be supplied to only one amplifier at a given point in time and enable supply of the electrical signal from the optical receiving device to the

other amplifiers to be prevented at that given point in time." Support for this amendment to claim 1 can be found throughout the application, including at Figure 2 and the corresponding discussion.

In contrast, the cited references, as presently understood, do not teach or suggest the aforementioned elements in combination with the other elements of claim 1, and Applicants accordingly submit that the pending claims are in condition for allowance.

By way of illustration only, Applicants note that the Examiner has alleged that it would be obvious to modify the *Davidson* device to include the switch S_1 of *Bayart*. See Office Action at 13. As amended however, claim 1 requires electrical switches, while switch S_1 of *Bayart* is an optical switch. See, e.g., *Bayart* Abstract. As another example, the Examiner has alleged that it would be obvious to modify the *Davidson* device to include the switches 18 and 22 of *Geller* as those switches are arranged in the *Geller* device. See Office Action at 18. However, inasmuch as *Davidson* indicates a need for an arrangement "...wherein the first gain path and the second gain path are configured to simultaneously amplify the electrical signal..." (see, e.g., claim 1; emphasis added), modification of the *Davidson* device to include the switches 18 and 22 of *Geller* gives rise to the possibility that the *Davidson* gain paths could be prevented from simultaneously amplifying an electrical signal, e.g., where one of the switches 18 or 22 is open. Inasmuch as the combination proposed by the Examiner may result in impairment of the functionality of the *Davidson* device, the person of ordinary skill in the art would be disinclined to make such a combination.

III. Charge Authorization

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in allowable condition. In the event that Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview or overcome by an Examiner's Amendment, Examiner is requested to contact the undersigned attorney.

Dated this 23rd day of March, 2009.

Respectfully submitted,

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